IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Yoshiyuki MIYAGAWA et al.   Art Unit : 3714

Appl. No. : 10/765,975   Examiner : Corbett B. Coburn

Filed : January 29, 2004   Conf. No. : 2821

For : VIDEO GAME WITH FAST FORWARD AND SLOW MOTION FEATURES

PRE-APPEAL BRIEF REQUEST FOR REVIEW

U.S. Patent and Trademark Office
Customer Window, Mail Stop <u>AF</u>
Randolph Building
401 Dulany Street
Alexandria , VA 22314

Sir:

In response to the Final Official Action of December 4, 2008, in which a three-month shortened statutory period for response was set to expire on March 4, 2009, and which has been extended by the enclosed Request for Extension of Time set to expire on April 6, 2009 (April 4, 2009 being a Saturday), and for which a Notice of Appeal is being concurrently filed, Applicants respectfully request a Pre-Appeal Brief Panel to review and withdraw the outstanding rejection set forth in the above-mentioned Final Official Action in view of the herein-contained remarks.

REMARKS

Status of Claims

Claims 1-2, 4-7, and 9-10 are pending in the present application with claims 1, 4, 6, and 9 being in independent form, and claims 3 and 8 are withdrawn.

35 U.S.C. § 103 Rejection based on Deering

In the Final Office Action, claims 1-2, 4-7, and 9-10 (*i.e.*, all pending claims) were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,313,838 to Deering (hereinafter "DEERING"). This rejection is respectfully traversed.

Independent Claim 1

The present application generally relates to a method and a computer readable medium for dynamically changing a game progressing speed based upon an operation of a player. Specifically, independent claim 1, as listed in the Response of July 8, 2008, recites a computer readable medium including, in part:

> . . . *determining game progress to be made by said frame images, in dependence upon the formation time periods of said frame images, as predicted; and*
>
> *changing said determined game progress, in response to an operation input by a player,*
>
> *wherein the rate of tempo of game music and the rate of formation of said frame images and said determined game progress is increased, when a player inputs a first predetermined instruction, and*
>
> *wherein the rate of tempo of the game music and the rate of formation of said frame images and said determined game progress is decreased, when a player inputs a second predetermined instruction.*

According to the above-recited features, the game progress of the video game is determined by the rate of formation of the frame images which constitute the video game. In this regard, a first predetermined instruction input by a player increases the rate of formation of the frame images and increases the rate of tempo of game music to increase the game progress of the video game while a second predetermined instruction input by a player decreases the rate of formation of the frame images and decreases the rate of tempo of game music to decrease the game progress of the video game.

With respect to the above-recited feature of independent claim 1 of changing the determined game progress in response to an operation input by a player, the Examiner does not argue that DEERING discloses, or even suggests, such a feature.[1] Rather, the Examiner merely asserts, on page 2 of the Final Official Action of December 4, 2008, that video games inherently include changing the determined progress in response to an operation input by the player, such as character movement rates or directions. Thus, the Examiner unilaterally concludes that the feature of changing the determined game

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[1] Applicants note that DEERING appears to disclose maintaining a minimum frame rate in a video game (not a constant frame rate as asserted y the Examiner). In this regard, DEERING discloses estimating scene rendering time on a frame-by-frame basis to ensure that the minimum frame rate is maintained. If the minimum frame rate will not be maintained, then DEERING discloses adjusting rendering parameters, such as the number shapes, pixels, features, etc., of the frames to be displayed in order to maintain the minimum frame rate. (DEERING, col. 3, lines 55-60)

progress in response to an operation input by a player is obvious. In this regard, Applicants initially note that independent claim 1 explicitly recites that the rate of formation of the frame images is increased or decreased based upon a user input and that the game progress is based upon the formation time periods of the frame images. Thus, according to independent claim 1, the game progress is not changed by mere character movement rates or direction as asserted by the Examiner. Furthermore, Applicants submit that it cannot be reasonably asserted that video games inherently include changing the progress of the video game, by increasing or decreasing the rate of formation of frame images, in response to an operation input by a player.

Furthermore, with respect to the Examiner's unilateral determination of obviousness, Applicants respectfully submit that the Examiner has failed to provide any support for such a determination and has failed to articulate any rationale behind such a determination. As discussed in section 2142 of the MPEP:

> The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in KSR International Co. v. Teleflex Inc., 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also KSR, 550 U.S. at ___ , 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Thus, in order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103, Applicants submit that the Examiner must clearly and explicitly set forth the reasons and/or provide support for a determination of obviousness. Applicants respectfully submit that the Examiner has failed to satisfy this burden.

To the contrary, on pages 3-4 of the outstanding Final Office Action, the Examiner merely asserts that "it is well within the level of ordinary skill to speed up or slow down the tempo of actions on a screen or music in response to a user input." The Examiner further asserts, on page 4 of the outstanding Final Office Action, that such a feature "could, in fact, be implemented by anyone who is taking his very first programming course in school." The above-quoted assertions of the Examiner are merely cursory conclusions which are the textbook definition of hindsight. That is, the

Examiner has failed to clearly articulate any appropriate reason to support the conclusion of obviousness, and is instead, relying on impermissible hindsight by relying on the disclosed advantages of the present application as a roadmap for determining obviousness.

In addition to, and independently of the above, with respect to the features of independent claim 1 of increasing and decreasing the rate of tempo of game music and the rate of formation of the frame images in response to a user input, the Examiner merely asserts that these features are a matter of design choice that are well within the level of ordinary skill in the art. Thus, the Examiner does not even argue whether DEERING discloses or renders obvious increasing and decreasing a rate of tempo of game music and a rate of formation of frame images based on a user input. In this regard, Applicants note that the Board of Patent Appeals and Interferences (BPAI) has determined that a proper rejection under 35 U.S.C. § 103 must teach or suggest each and every claim feature. Specifically, according to the BPAI:

> When determining whether a claim is obvious, an examiner must make a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art. Thus, obviousness requires a suggestion of all limitations in a claim.[2]

Therefore, in order to establish a *prima facie* case of obviousness, Applicants submit that the Examiner must explicitly address each of the limitations of the claims. The feature of increasing and decreasing a rate of tempo of game music and a rate of formation of frame images cannot be reasonably interpreted to be a mere matter of design choice. To the contrary, such features enable a player to control the rate at which a video game progresses. Accordingly, at least in view of the fact that the Examiner failed to address the limitations of increasing the rate of tempo of game music and the rate of formation of the frame images when a player inputs a first predetermined instruction and decreasing the rate of tempo of game music and the rate of formation of the frame images when a player inputs a second predetermined instruction, Applicants submit that the burden to establish a *prima facie* case of obviousness has not been satisfied.

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[2] *See In re Wada and Murphy*, Appeal 2007-3733, *citing In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) and *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)).

Accordingly, at least for the reasons set forth above, Applicants respectfully request withdrawal of the rejection of independent claim 1 under 35 U.S.C. § 103.
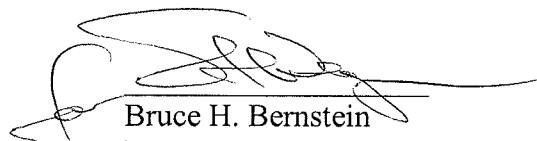
Independent Claims 4, 6, and 9

With respect to the rejection of independent claims 4, 6, and 9 under 35 U.S.C. § 103, for at least the reasons set forth above, Applicants submit that the Examiner has similarly failed to set forth a *prima facie* case of obviousness. Specifically, Applicants submit that the Examiner has failed to clearly articulate an appropriate reason to support a finding of obviousness of the features of "determining game progress to be made by said frame images, in dependence upon the formation time periods of said frame images, as predicted; and changing said determined game progress, in response to an operation input by a player." Furthermore, Applicants submit that the Examiner has failed to address at least the claimed features of "wherein the rate of tempo of game music and the rate of formation of said frame images . . . is increased, when a player inputs a first predetermined instruction" and "wherein the rate of tempo of game music and the rate of formation of said frame images . . . is decreased, when a player inputs a second predetermined instruction." Thus, Applicants respectfully request withdrawal of the rejections of claims 4, 6, and 9 under 35 U.S.C. § 103.

Conclusion

In view of the above, reconsideration of the Final Office Action and allowance of the present application and all the claims therein are respectfully requested.

Respectfully submitted,
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